

REMARKS

This Response is to the non-final Office Action dated March 3, 2010, and the telephone interview of April 16, 2010 courteously granted by the Examiner. Claims 1 to 8, 15 to 20, 27, 29 to 33, 40, 47 to 52, 55 to 57, 61 to 63, 67 to 69, 73 to 75, 79, 81 to 84 and 91 are pending. New claim 91 has been added. No new matter is added by the amendments or addition. Claims 9 to 14, 21 to 26, 28, 34 to 39, 41 to 46, 53, 54, 58 to 60, 64 to 66, 70 to 72, 76 to 78, 80 and 85 to 90 have been cancelled in this response, without disclaimer, to place this application in condition for allowance. Claims 1, 15, 27, 40, 47, and 79 have been amended. Please charge Deposit Account No. 02-1818 for any costs associated with this Response.

Current Status of Claims

Claims 1, 7 to 9, 15, 20, 21, 27 to 32, 34, 35, 37 to 41, 46, 47, 53 to 56, 58, 59, 61, 62, 64, 65, 67, 68, 70, 71, 73, 74, 76, 77 and 79 to 90 are rejected in the Office Action.

Claims 2 to 6, 10 to 14, 16 to 19, 22 to 26, 33, 36, 42 to 45, 48 to 52, 57, 60, 63, 66, 69, 72, 75 and 78 are objected to as being dependent upon a rejected base claim.

35 U.S.C. § 102(b) Rejection

The Office Action rejected claims 1, 7 to 9, 15, 20, 21, 27 to 32, 34, 35, 37 to 41, 46, 47, 53 to 56, 58, 59, 61, 62, 64, 65, 67, 68, 70, 71, 73, 74, 76, 77, and 79 to 90 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5, 441, 487 to Vedder ("*Vedder*"). Applicants respectfully traverse the rejection over the claims as presently presented for the following reasons, addressing each independent claim in turn.

The claims of the present application have been amended, as discussed and generally agreed upon with the Examiner in the telephone interview of April 16, 2010, to greater define the aspects of the invention and clarify how the presently presented claims are novel and not anticipated by *Vedder*. Applicants respectfully submit that each of independent claims 1, 15, 27, 40, 47, 79 and 91 has also been amended to correct a minor antecedent basis error, and specify that the passageway into which the second portion extends is the first passageway. This clarifying amendment has in no way been made to overcome the art of record or to disclose any subject matter with respect to same.

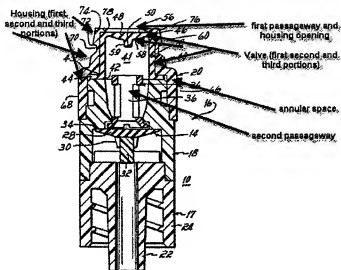


FIG. 1

[Office Action, page 5]

Claim 1

The Office Action asserts that *Vedder* discloses each and every element of claim 1 by labeling and identifying the different relevant parts of Fig. 1 of *Vedder*, as shown above. As discussed in the telephone interview, the structure of *Vedder* is fundamentally different from the features of claim 1 in at least two ways. First, *Vedder* does not include a third valve portion that extends from the lower portion of the second valve portion. Second, *Vedder* does not disclose a second valve portion that extends generally vertically downward within the first passageway. Each distinction is addressed below.

First, the Office Action interprets feature 56 of *Vedder* to be the first valve portion, features 58/59 to be the second valve portion, and features 40/44 to be the third valve portion. [Office Action, p.3 and p.5] Applicants respectfully submit that even under the Office Action's interpretation, *Vedder* fails to disclose a first valve portion, a second valve portion integral with the first valve portion and extending generally vertically downward within the first passageway from a lower surface of the first valve portion, and a third valve portion extending from a lower surface of the second valve portion. Specifically, the third valve portion 40/44 of *Vedder* does not extend from a lower surface of the second valve portion. Feature 59 (the "second valve portion" according to the Office Action) terminates in the middle of passageway 41. Nothing

extends from the lower portion of 59. Even if the first valve portion is considered to be taught by feature 56, the second valve portion feature 58 and the third valve portion feature 59, the third valve portion 59 does not include a lower end portion, which is attached to the housing to form a sealed second passageway within the third valve portion, as required by amended claim 1. Therefore, as discussed and generally agreed upon in the interview of April 16, 2010, claim 1 is structurally distinguished over *Vedder*.

Claim 1 has been slightly amended as requested by the Examiner to specify that the third valve portion extends “from a lower surface of the second valve portion” rather than “extending from one of a lower surface of a second valve portion and a lower surface of said first valve portion.” For at least the reasons stated above and for the reasons discussed in the telephone interview, *Vedder* fails to disclose the revised claim language. Applicants further respectfully submit that it would not have been obvious to one of ordinary skill in the art to modify *Vedder* to have the third valve portion 40/44 extend from a lower surface of the second valve portion, wherein a lower end portion of the third valve portion is attached to the housing to form a second passageway within the third valve portion. Such modification would require the clear teachings of *Vedder* to be undone and destroyed.

Second, the Office Action interprets the area above the valve 48 in *Vedder* to be the first passageway (see *Vedder* Fig. 1 reproduced above). Applicants respectfully submit that in *Vedder*, the area above the valve does not teach the first part of claim 1 because claim 1 requires the second valve portion integral with the first valve portion to extend generally vertically downward within the first passageway from a lower surface of the first valve portion. The “first passageway” of *Vedder* (i.e., “space near 78 opening” according to the Office Action) is located in the housing but above the entire valve structure. Therefore, regardless of how the first, second and third valve portions of *Vedder* are defined, *Vedder* does not disclose a second valve portion integral with the first valve portion and extending generally vertically downward within the first passageway from a lower surface of the first valve portion and as discussed in the telephone interview. Even if, in the alternative, the area of *Vedder* identified by reference numeral 41 is considered to be the claimed first passageway, *Vedder* still fails to disclose a sealed second passageway within the third valve portion, as required by claim 1.

Regarding the second passageway of claim 1, claim 1 specifies “a lower end portion of said third portion [is] attached to said housing to form a sealed second passageway”. Applicants

submit that in one embodiment, the “sealed second passageway” is the passageway bound (i) from the top by the lower end portion of the third valve portion and (ii) from the sides by the housing. The specification clearly supports this embodiment of “second passageway” at, for example:

A valve element, generally indicated at 320, provides at least one seal against pressurized fluid within an exit passageway 324 formed by portions of the extension 308 and housing 304. The exit passageway 324 is in fluid communication with a device 326 in fluid communication with a body.

[Specifically, column 15, lines 33 to 38].

For each of the above-described reasons, Applicants respectfully submit that claim 1 and claims 2 to 8 depending from claim 1 are patentable over the applied art and in condition for allowance. Presently presented independent claims 15, 27, 40, 47 and 79 contain elements similar to the ones just discussed for distinguishing claim 1 over *Vedder*. Accordingly, for the same reasons stated above with respect to claim 1, each of independent claims 15, 27, 40, 47 and 79 is also patentably distinguished over the applied art.

Each of the remaining independent claims, has been amended slightly as agreed upon in the telephone interview, and is discussed below.

Claim 15

Claim 15 contains similar features as claim 1, and has also been amended as requested by the Examiner to specify that the third valve portion extends “from a lower surface of the second valve portion” rather than “extending from one of a lower surface of a second valve portion and a lower surface of said first valve portion.” For the same reasons as discussed above with respect to claim 1, *Vedder* does not disclose the features of amended claim 15. Specifically, claim 15 includes, and *Vedder* fails to disclose: a resealable valve with a second portion integral with a first portion and extending generally vertically downward within a first passageway from a lower surface of the first portion, the valve having a third portion extending from a lower surface of the second portion. *Vedder* also fails to disclose a lower end portion of the third portion attached to the housing to form a sealed second passageway, the valve and the housing defining a space between the valve and the housing.

Applicants also respectfully submit that claim 15 has been slightly amended to clarify that the housing having an upper end portion is configured to receive the male luer assembly.

The claim erroneously omitted the verb “receive”, and has been amended in this response for readability. This minor amendment has in no way been made to overcome the art of record or to disclose any subject matter with respect to same.

For at least these reasons, and the reasons discussed above, Applicants respectfully submit that claim 15 and claims 16 to 20 and 55 to 57 depending from claim 15 are patentable over the applied art and in condition for allowance.

Claim 27

As requested by the Examiner, claim 27 has been amended to clarify that the valve has a third portion directly attached to the second portion, the third portion having a lower end portion sealingly attached to the housing. Applicants respectfully submit that it is clear from the disclosure that the first, second and third valve portions are directly or integrally formed as a unitary piece to make up the valve.

Claim 27 has also been amended to correct the antecedent basis of a feature, and recite: “the third portion having a lower end portion and sealingly attached to the housing”. This amendment properly defines the element “the lower end portion” of the third portion, which is later recited in line 19: “the attachment of said lower end portion of said third portion to said housing...” Applicants respectfully submit that this minor amendment has in no way been made to overcome the art of record or to disclose any subject matter with respect to same.

For at least these reasons, and the reasons discussed above, Applicants respectfully submit that claim 27 and claims 29 to 33 and 61 to 63 depending from claim 27 are patentable over the applied art and in condition for allowance.

Claim 40

Claim 40 has been amended as requested by the Examiner to specify that the valve has a third portion extending from a lower surface of the second portion. As discussed in the interview and above, Applicants respectfully submit that this amendment distinguishes claim 40 over *Vedder*.

For at least this reason, and the reasons discussed above, Applicants respectfully submit that claim 40 and claims 67 to 69 depending from claim 40 are patentable over the applied art and in condition for allowance.

Claim 47

Similar to claim 27, claim 47 has been amended, per the suggestion of the Examiner, to clarify that the valve has a third portion directly attached to the second portion, the third portion having a lower end portion sealingly attached to the housing. As discussed above, Applicants respectfully submit that it is clear from the disclosure that the first, second and third valve portions are directly or integrally formed as a unitary piece to make up the valve.

Claim 47 has also been amended to correct the antecedent basis of a feature, and recite: "the attachment of said ~~lower-end~~ portion of said third portion to said housing being such that fluid injected from said tip does not flow into said space". This amendment properly recites the element "the attachment of said portion of said third portion", which is first introduced in lines 12 to 14: "and a third portion directly attached to a lower surface of said second portion, a portion of said third portion attached to said housing to form a sealed section passageway." Applicants respectfully submit that this minor amendment has in no way been made to overcome the art of record or to disclose any subject matter with respect to same.

For all the reasons discussed above, Applicants respectfully submit that claim 47 (and claims 48 to 52 and 73 to 75 depending from claim 47) is patentable over applied art and is in condition for allowance.

Claim 79

Similar to claim 1, claim 79 has been amended to specify that the third valve portion extends from a lower surface of the second valve portion, rather than “extending from one of a lower surface of said second valve portion and a lower surface of said first valve portion.” As discussed above, Applicants respectfully submit that this amendment clarifies the structural distinction between the claims and *Vedder*, and therefore claim 79 (and claims 81 to 84 depending from claim 79) are also in condition for allowance.

Allowable Subject Matter – New Claim 91

On page 7 of the Office Action, Claims 2 to 6, 10 to 14, 16 to 19, 22 to 26, 33, 36, 42 to 45, 48 to 52, 57, 60, 63, 66, 69, 72, 75, and 78 were objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. New claim 91 includes the elements of objected to but otherwise allowable dependent claim 57, as well as previously presented claim 15, from which claim 57 directly depended. Apart from the inclusion of the features of claim 57, claim 91 differs from previously presented claim 15 in two minor ways. First, claim 91 recites: “said housing having an upper end portion configured to receive the male luer assembly when the male luer tip is inserted downward into said opening”. As discussed above with respect to amended claim 15, previously presented claim 15 erroneously omitted the verb “receive”. In drafting new allowable claim 91, this error has been corrected. Second, claim 91 has been corrected as each of the other independent claims have, to specify that the passageway into which the second portion extends is the first passageway. These minor amendments have in no way been made to overcome the art of record or to disclose any subject matter with respect to same. Accordingly, Applicants respectfully submit that claim 91, which includes all of the features of previously presented claims 15 and 57, as well as the two minor amendments discussed above, is patentable over the prior art, and in condition for allowance.

Cancelled Claims

As discussed in the telephone interview, several claims have been cancelled without disclaimer in the interest of expediting prosecution and bringing the application to a condition for allowance. Specifically, independent claim 9 (and dependant claims 10 to 14), independent claim 21 (and dependent claims 22 to 26 and 58 to 60), dependent claim 28, independent claim 34 (and dependent claims 35 to 39 and 64 to 66), independent claim 41 (and dependent claims 42 to 46 and 70 to 72) and claim 54 (and dependent claims 54 and 76 to 78) have been cancelled in this response, and therefore the rejection of each of these claims is moot.

For at least the above reasons, Applicants respectfully submit that amended independent claims 1, 15, 27, 40, 47, 79 and 91 (as well as each claim depending respectively therefrom) are patentably distinguished over the applied art and are in condition for allowance. An earnest endeavor has been made to place this application in condition for formal allowance and is courteously solicited. If the Examiner has any questions regarding this Response, Applicant respectfully requests that the Examiner contact the undersigned.

Respectfully submitted,

K&L Gates LLP

BY 

Philip A. Kunz
Reg. No. 62,290
Customer No. 29200
(312) 807-4294

Dated: June 3, 2010